

**REMARKS**

An Excess Claim Fee Payment Letter is submitted herewith for nine (9) excess total claims.

Claims 1-57 are all the claims presently pending in the application. Claims 1, 2, 4, 13, 14, 36, and 48 have been amended to define more clearly the features of the present invention. Claims 49-57 have been added to provide more varied protection for the invention. Claims 1, 4, 7, 15, 21, 25, 29, 37, 40, and 43 are independent.

It is noted that the claim amendments are made only for more particularly pointing out the invention, and not for distinguishing the invention over the prior art, narrowing the claims or for any statutory requirements of patentability. Further, Applicant specifically states that no amendment to any claim herein should be construed as a disclaimer of any interest in or right to an equivalent of any element or feature of the amended claim.

Applicant gratefully acknowledges that claims 13, 14, 16, 18, 32, 36, 44, 46 and 48 would be allowable if rewritten in independent form. However, Applicant respectfully submits that all of the claims are allowable.

Claims 33 and 34 stand rejected upon informalities (e.g., 35 U.S.C. § 112, second paragraph). Claims 1-3, 7, and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Swartz, et al. (U.S. Patent No. 6,330,244, hereinafter "Swartz"), in view of Sashihara (U.S. Patent No. 6,434,405). Claims 4-6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sashihara, in view of Swartz. Claims 15, 17, 19, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Alperovich, et al. (U.S. Patent No. 6,317,609; hereinafter "Alperovich"), in view of Swartz, in further view of Sashihara. Claims 9-12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sashihara, in view of Swartz, et al, in further view of Alperovich. Claims 21-30, and 35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pettersson (U.S. Patent No. 6,615,057), in view of Swartz. Claim 31 stands rejected under 35 U.S.C. § 103(a) as

being unpatentable over Pettersson and Swartz, in further view of Alperovich. Claims 37-43 and 47 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Swartz, in view of Mousseau, et al. (U.S. Patent No. 6,438,585, hereinafter "Mousseau"). Claim 45 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Swartz and Mousseau, in further view of Alperovich.

These rejections are respectfully traversed in the following discussion.

## **I. THE CLAIMED INVENTION**

The claimed invention as defined, for example, in independent claim 1, is directed to a wireless telephone that receives data of at least one of an image and characters through a transmitting provider. The wireless telephone includes a detector for detecting the data to be received from the transmitting provider, a designating device for designating the data for reception by the wireless telephone from the transmitting provider and for selectively designating an apparatus to which the received data is to be transmitted, and a wireless communicating device that communicates with the apparatus without the transmitting provider and transmits the data to the apparatus designated by the designating device. The claimed telephone also includes a display device for displaying a menu for designating at least one of transmitting data and receiving data.

The claimed invention provides a user with an ability to designate at least one of transmitting and receiving data. Thus, the display device in the claimed telephone displays a menu for designating at least one of transmitting data and receiving data. For example, when the telephone detects data which may be received/transmitted, a user may view the menu on the display device and use a designating device to designate whether the data should be received by the telephone or transmitted to a designated apparatus.

## II. THE 35 U.S.C. §112, SECOND PARAGRAPH REJECTION

Claims 33 and 34 stand rejected under 35 U.S.C. §112, second paragraph. The claims have been amended, above, to overcome this rejection.

In view of the foregoing, the Examiner is respectfully requested to reconsider and withdraw this rejection.

## III. THE PRIOR ART REJECTIONS

For the Examiner's convenience, Applicant incorporates by reference the remarks submitted in the Amendments under 37 C.F.R. § 1.116 filed on October 22, 2003 and November 24, 2003.

### A. Claims 1-3, 7, and 8:

Claims 1-3, 7, and 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Swartz in view of Sashihara. For at least the following reasons, Applicant respectfully traverses this rejection.

In the Response to Arguments, the Examiner alleges that “[t]he displayed data designated to be received by the user can be data the user chose from a menu such as which messages to read and more details pertaining to the message are displayed by a menu option the user presses on the keypad; or the designating data can be [data] the user had picked through the user interface to receive from the host designated to be displayed on the user's display screen or the designated transmitting data could be text/messages entered by the user through the user keypad and saved through a menu option and later designated to be sent out to another mobile device” (see Office action at page 2, first paragraph).

Applicant respectfully submits, however, that choosing which messages to read from a list of messages, such as text messages, and subsequently forwarding the text messages to another phone after the entire message is received by the portable phone is completely different than “a detector for detecting the data to be received from the

transmitting provider” and “a designating device for designating the data for reception by the wireless telephone from the transmitting provider and for selectively designating an apparatus to which the received data is to be transmitted” as claimed in independent claim 1.

The claimed invention provides a user with an ability to designate at least one of transmitting and receiving data.

That is, when the telephone detects data which may be received/transmitted, a user may view the menu on the display device and use a designating device to designate whether the data should be received by the telephone or transmitted to a designated apparatus without using the transmitting provider.

Thus, the present invention provides high-speed communicating ability with the apparatus without the transmitting provider by transmitting the data received through the transmitting provider through the wireless communication device to the apparatus, which then stores, displays, or prints the data. As such, the claimed invention can receive the data and transmit the data to an apparatus even if the telephone cannot store all of the data or display the image of high quality due to the small recording capacity or poor performance of the displaying device of the telephone (e.g., see specification at page 6, lines 19-26).

In other words, by permitting the user to designate data for reception by the wireless telephone prior to receipt of the data from the transmitting provider and to selectively designate an apparatus to which the received data is to be transmitted, the claimed invention overcomes the conventional problems associated with small recording capacity or poor performance of the displaying device of the wireless telephone.

Particularly, independent claim 1 recites, *inter alia*, a wireless telephone that receives data of at least one of an image and characters through a transmitting provider, the wireless telephone comprising:

a detector for detecting the data to be received from the

transmitting provider;

a display device which displays a menu for designating at least one of transmitting data and receiving data;

a designating device for designating the data for reception by the wireless telephone from the transmitting provider and for selectively designating an apparatus to which the received data is to be transmitted; and

a wireless communicating device that communicates with the apparatus without the transmitting provider and transmits the data to the apparatus designated by said designating device (emphasis added).

Assuming *arguendo* that a person of ordinary skill in the art at the time of the invention would have been motivated to combine the references, Applicant respectfully submits that neither Swartz nor Sashihara discloses nor suggests the novel and unobvious combination of elements of the claimed invention including, for example, “a designating device for designating the data for reception by the wireless telephone from the transmitting provider and for selectively designating an apparatus to which the received data is to be transmitted” as claimed. Moreover, neither Swartz nor Sashihara discloses nor suggests the novel and unobvious combination of elements of the claimed invention including “a wireless communicating device that communicates with the apparatus without the transmitting provider and transmits the data to the apparatus designated by said designating device” as claimed.

For example, Swartz merely discloses a wireless local area network for digital radio communication between mobile units and a private branch exchange (PBX) telephone system. In Swartz, a wireless phone is provided for voice and data communication through the PBX or a central office (CO) telephone line with remote locations or the Internet using digital data packets and standard Internet Protocol (e.g., see Swartz at Abstract).

However, as mentioned above, by merely selecting text messages to read and subsequently forwarding such text messages to another telephone, Swartz is not capable of receiving and transmitting data to the apparatus even if the telephone

cannot store all of the data or display the image of high quality due to the small recording capacity or poor performance of the displaying device of the telephone.

Sashihara, on the other hand, does not make up for the deficiencies of Swartz. For example, Sashihara merely discloses a transmitting and receiving card selectively attached to a portable phone or an information terminal. When the card is attached to the portable phone, the card acts as the information terminal so as to retrieve information such as e-mail stored in a server via the portable phone, and to transmit information stored in advance in the card to such a server according to a request (e.g., see Sashihara at Abstract).

Alternatively, in Sashihara, when the card is attached to the e-mail terminal, the card acts as if the card were the mail server. That is, the terminal can transmit or receive e-mail with the card in the same way as with the mail server.

In other words, the card itself must be detached from the portable phone and attached to the e-mail server, since only a single card is disclosed by Sashihara. Thus, there is no “wireless communication” between the portable phone and the e-mail terminal. Instead, the removable card is simply detached from the portable phone and then attached to the e-mail terminal and visa versa.

That is, the card communicates with the server while attached to the portable phone and, on one hand, sends e-mail messages stored in advance on the card to the server, and on the other hand, receives e-mail from the server. The card is then detached from the portable phone and attached to the e-mail terminal, at which time it can communicate the stored e-mail messages (which it received from the server) to the e-mail terminal and retrieve outgoing e-mail from the e-mail terminal (which it stores until the card is detached from the e-mail terminal and attached to the portable phone).

Thus, contrary to the Examiner’s position, Sashihara does not disclose or suggest “a wireless communicating device that communicates with the apparatus without the transmitting provider and transmits the data to the apparatus designated by said designating device” as claimed.

In fact, the Office Action specifically acknowledges that Sashihara does not disclose or suggest “a wireless communicating device that communicates with the apparatus without the transmitting provider” according to the claimed invention (see Office Action at page 6, line 21 to page 7, line 2).

Moreover, since the card of Sashihara merely is detached from the portable phone and attached to the e-mail terminal and visa versa, the storage capacity of the card would be limited. Thus, any combination of Swartz and Sashihara still could not provide one of the advantages of the claimed invention, such as receiving the data and transmitting the data to an apparatus even if the telephone cannot store all of the data or display the image of high quality due to the small recording capacity or poor performance of the displaying device of the telephone.

Similarly, since the card of Sashihara merely is detached from the portable phone and attached to the e-mail terminal and visa versa, there would be no need to designate the apparatus to which the received data is to be transmitted, as claimed.

Moreover, assuming *arguendo* that the cited references separately disclose the individual elements of the claimed invention, Applicant respectfully submits that there would not have been a motivation to combine these references to arrive at the claimed invention in as complete detail as recited in the claims.

As set forth in the Amendment under § 1.116 filed on October 22, 2003 (which is incorporated herein by reference), these references would not have been combined as alleged by the Examiner since these references are directed to different problems and solutions.

The Office Action also does not point to a reasonable motivation or suggestion in the references to urge the combination as alleged by the Examiner, but rather, merely states that it would have been obvious to combine these references “*to have the wireless connection in order to avoid the inconvenience of using a cable/line connection*” (see Office Action at page 4, lines 15-17). However, as mentioned above, combining the removable card of Sashihara with the device of Swartz to avoid

the inconvenience of using a cable/line connection still would result in a device with limited storing capacity, and thus, would not provide any of the disclosed advantages of the claimed invention.

Therefore, Applicant respectfully submits that these references would not have been combined and even if combined, the combination would not teach or suggest each and every element of the claimed invention. Therefore, the Examiner is respectfully requested to withdraw this rejection.

**B. Claims 4-6:**

Claims 4-6 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sashihara, in view of Swartz. For at least the following reasons, Applicant respectfully traverses this rejection.

For reasons similar to those set forth above, Applicant respectfully submits that neither Swartz nor Sashihara discloses or suggests all of the features of the novel and unobvious method recited in independent claim 4.

Moreover, Applicant submits that the Office Action does not provide a reasonable motivation in the reference or in the art in general, for doing that which the inventor has done.

The Office Action alleges that it would have been obvious to combine Swartz and Sashihara "*in order to forward the data to another device from the wireless phone for viewing when the mobile does not have enough display or memory capabilities to view the entire data file*" (see Office Action at page 7, lines 10-13).

However, neither Swartz nor Sashihara discloses, suggests, or for that matter, even mentions this feature. Thus, Applicant respectfully submits that the Office Action has not established a reasonable motivation for combining the references, absent impermissible hindsight.



**C. Claims 15, 17, 19, and 20:**

Claims 15, 17, 19, and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Alperovich, et al. (U.S. Patent No. 6,317,609; hereinafter “Alperovich”), in view of Swartz, in further view of Sashihara. For at least the following reasons, Applicant respectfully traverses this rejection.

Independent claim 15 recites, *inter alia*, a method for transmitting data over a transmitting provider, including:

- transmitting data from a first wireless telephone to a second wireless telephone through a transmitting provider;
- detecting, on the second wireless telephone, the data to be received from the first wireless telephone;
- displaying information from the detected data on a display on the second wireless telephone and displaying a menu for designating at least one of transmitting data and receiving data;
- designating the data for reception by the second wireless telephone;
- receiving the data into the second wireless telephone;
- designating an apparatus to which the received data is to be transmitted from the second wireless telephone; and
- transmitting the designated data to the designated apparatus without the transmitting provider through a wireless connection device installed on the second wireless telephone.

For reasons similar to those set forth above, Applicant respectfully submits that neither Swartz nor Sashihara discloses or suggests all of the features of the novel and unobvious method recited in independent claim 15.

That is, Alperovich does not make up for the deficiencies of Swartz and Sashihara as mentioned above, since the Office Action acknowledges that Alperovich does not disclose or suggest the claimed “designating an apparatus”, “transmitting the designated data to the designated apparatus without the transmitting provider through a wireless connection device installed on the second wireless telephone”, and displaying a menu for designating” as recited in claim 15 (see Office Action at page 8,

lines 17-22).

Moreover, Applicant submits that a person of ordinary skill in the art at the time of the invention would not have been motivated to combine the references in the alleged manner.

For example, Alperovich merely discloses a telecommunications system for transmitting digital images produced by a digital camera attached to or integrated with a mobile station (MS) from the MS to a receiving terminal through the Internet (e.g., see Alperovich at Abstract). Specifically, Alperovich is directed to a system for transmitting digital images which allegedly improves the quality of a digital image by reducing the load on the cellular and fixed networks (e.g., see Alperovich at col. 3, lines 49-53).

This is completely unrelated to the systems of Swartz and Sashihara. Therefore, no person of ordinary skill in the art would have considered combining these disparate references, absent impermissible hindsight.

Further, Applicant submits that the Office Action does not provide a reasonable motivation in the reference or in the art in general, for doing that which the inventor has done, but rather, merely states that it would have been obvious to combine these references *“in order to transfer the image/data file to another peripheral device when the wireless phone doesn’t have enough capacity to load the entire sent data”*.

However, Alperovich is intended to reduce the load on a network, and does not address or, for that matter even mention, a capacity of a wireless telephone. Therefore, the Office Action’s allegations are insufficient to support the alleged combination.

Therefore, for these reasons, as well as the reasons set forth in the Amendment under § 1.116 filed on October 22, 2003 (which is incorporated herein by reference), Applicant respectfully submits that these references would not have been combined and even if combined, the combination would not teach or suggest each and every element of the claimed invention. Therefore, the Examiner is respectfully requested to

withdraw this rejection.

**D. Claims 9-12:**

Claims 9-12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sashihara in view of Swartz and further in view of Alperovich. For at least the following reasons, Applicant respectfully traverses this rejection.

For reasons similar to those set forth above, Applicant submits that neither Sashihara, Swartz, nor Alperovich, either alone or in combination, discloses or suggests all of the recitations of claims 9-12.

Accordingly, the Examiner is requested to withdraw this rejection.

**E. Claims 21-30 and 35:**

Claims 21-30, and 35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pettersson (U.S. Patent No. 6,615,057), in view of Swartz. For at least the following reasons, Applicant respectfully traverses this rejection.

With respect to claim 30, Applicant submits that claim 30 is allowable at least for reasons similar to allowable claim 32.

With respect to claims 21-29 and 35, the Office Action acknowledges that Pettersson does not disclose or suggest transmitting the received data to another apparatus (see Office Action at page 12, lines 14-15).

As mentioned above, Swartz also does not disclose or suggest this feature of the novel and unobvious combination of elements according to the claimed invention. That is, merely receiving text messages and subsequently forwarding text messages to another telephone is not comparable to the claimed invention nor does such an arrangement provide the clear advantages of the claimed invention. Thus, any combination of Pettersson and Swartz clearly would not arrive at the claimed invention.

Moreover, the Office Action alleges that it would have been obvious to

combine Pettersson and Swartz “*to send the data to a designated apparatus in order to allow the mobile user to dictate where to send the data when the mobile user doesn't want to view or doesn't have enough space to view the data from the mobile phone itself*” (see Office Action at page 12, lines 16-20).

However, the Office Action does not cite any support in the references themselves, or the art in general, for this motivation. Thus, Applicant respectfully submits that a reasonable motivation for combining these references has not been established.

Applicant respectfully requests that the Examiner withdraw this rejection.

**F. Claim 31:**

Claim 31 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Pettersson and Swartz, in further view of Alperovich. For at least the following reasons, Applicant respectfully traverses this rejection.

As mentioned above, the Office Action acknowledges that Pettersson does not disclose or suggest transmitting the received data to another apparatus (see Office Action at page 12, lines 14-15). Swartz also does not disclose or suggest this feature of the novel and unobvious combination of elements according to the claimed invention.

On the other hand, Alperovich merely is directed to a system for transmitting digital images which allegedly improves the quality of a digital image by reducing the load on the cellular and fixed networks (e.g., see Alperovich at col. 3, lines 49-53).

Thus, any combination of Pettersson, Swartz, and Alperovich clearly would not arrive at the claimed invention.

Moreover, the Office Action asserts that it would have been obvious to “*add the second wireless phone in order to send the image/data to a friend's cell phone for him/her to view.*” However, as mentioned above with respect to Swartz, merely sending text messages or image data to another telephone does not contemplate or

solve the problems addressed by the claimed invention, nor provide the clear advantages of the claimed invention. Thus, a person of ordinary skill in the art would not have been motivated to combine the references in the manner recited in the claimed invention.

Further, assuming *arguendo* that it would have been obvious to combine the references, any combination of the references still would not disclose or suggest all of the features of the claimed invention.

**G. Claims 37-43 and 47:**

Claims 37-43 and 47 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Swartz, in view of Mousseau, et al. (U.S. Patent No. 6,438,585, hereinafter "Mousseau"). For at least the following reasons, Applicant respectfully traverses this rejection.

The Office Action asserts that it would have been obvious to combine Swart and Mousseau "to determine if the mobile is capable of handling the loading of the data otherwise an alternative way of redirecting the data via an infrared or wireless link for better convenience of not using cables and modem to one of the peripheral deices or attachment displayers of Mousseau, i.e., fax, printer needs to be executed to view the data." (see Office Action at page 18, lines 4-8).

However, Mousseau does not disclose or suggest determining if the mobile is capable of handling the loading of the data as alleged, but rather, determines if the attachment displayers are capable of handling the attachment. Thus, Applicant respectfully submits that the stated motivation does not provide a reasonable motivation for combining the references to arrive at the claimed invention.

Specifically, Mousseau states that the mobile device will query attachment displayers in the local area of the mobile device to determine whether they can process the attachment. The displayers will then send back to the mobile device information pertaining to their location, electronic address, and the type of attachment files they

can handle. The mobile device then processes this information regarding the displayers and sends the host system an attachment displayer choice to use with the attachment. The host system receives the attachment displayer choice from the mobile device and sends the attachment to the chosen displayer either through the wireless network, directly through the Internet, via a LAN connection, via a telephone or cellular connection, or via any other type of connection (e.g., see column 16, lines 4-25).

Thus, the host sends the attachment to the attachment displayer. The mobile device does not send the attachment, but merely queries to see which displayer to tell the host that the attachment is to be sent.

Accordingly, any combination of Swartz and Mousseau still would not arrive at the claimed invention and Applicant respectfully requests that the Examiner withdraw this rejection.

#### **H. Claim 45:**

Claim 45 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Swartz and Mousseau, in further view of Alperovich. For at least the following reasons, Applicant respectfully traverses this rejection.

For reasons similar to those set forth above, neither Swartz, Mousseau, nor Alperovich discloses or suggests all of the features of the claimed invention. Moreover, there would not have been a motivation to combine the references to arrive at the claimed invention.

Therefore, Applicant respectfully requests that the Examiner withdraw this rejection.

#### **IV. NEW CLAIMS**

New claims 49-57 are added to provide more varied protection for subject matter similar to allowable claims 13, 14, 16, 18, 32, 36, 44, 46, and 48.

Applicant submits that claims 49-57 also are allowable at least for similar reasons as allowable claims 13, 14, 16, 18, 32, 36, 44, 46, and 48, as well as for the reasons set forth above.

## **V. FORMALITIES AND CONCLUSION**

The Office Action objects to allowable claims 13, 14, 36, 46, and 48 because of informalities. Allowable claims 13, 14, 36, and 48 are amended to obviate the objection, as suggested by the Examiner.

Applicant requests that the Examiner formally acknowledge the claim to foreign priority and receipt of the priority document filed on October 26, 2000.

Applicant also requests that the Examiner formally accept and approve the formal drawings filed on October 26, 2000.

In view of the foregoing, Applicant submits that claims 1-57, all the claims presently pending in the application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

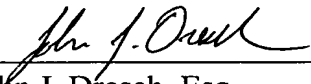
Serial No. 09/695,867  
Docket No. FJ-2000-027-US

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The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

Date: APRIL 30, 2004

  
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